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In re Application of	:	
Laurence E. Allen et al.	:	DECISION ON PETITION
Application No. 10/511,224	:	TO REVIEW RESTRICTION
Filed: June 28, 2005	:	REQUIREMENT UNDER
For: MULTISTEP SEPARATION OF PLASTICS	:	37 CFR § 1.144

This is in response to applicants' petition filed under 37 CFR 1.144 received October 6, 2009 requesting a review of the requirement for restriction made final in the July 6, 2009 Office action.

The petition is **GRANTED to the extent indicated below.**

The record shows that on July 11, 2008 the Examiner made a requirement for restriction based on lack of unity. Seventeen categories of invention were set forth. The Examiner insisted upon restriction because "Groups 1-17 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT 13.2, they lack the same or corresponding special technical features" because "[c]laim 15 describes a general plastic recycling process or the creation of a recycling process which is known and not considered a special technical feature." Thus the examiner has alleged that claim 15 does not define a "contribution" over the prior art, and therefore, does not contain a "special technical feature"; but, the examiner failed to cite any prior art reference, as is required by MPEP 1850. However, in the Office action mailed July 6, 2009, the examiner applied U.S. Patent No. 6,452,126 to Xiao against claim 15. By applying the reference, the examiner has demonstrated that claim 15 does not define a "contribution" over the prior art, and therefore does not contain a "special technical feature". Each of the seventeen groups set forth in the requirement for restriction was deemed by the examiner to contain a "special technical feature", i.e., a feature which makes a "contribution" over the prior art.

Applicants elected group 10 directed to the special technical feature of "triboelectric separation" and argued that all of the claims read on the elected group. In the Office action mailed July 6, 2009, the examiner disagreed with applicants' selection of claims because "only claims 45-53, 57, 59 and 60 actually require triboelectrostatic separation and are thus properly part of the elected group 10."

Decision on Petition

A reading of claim 15, which the examiner considered to be generic as it is included in each of the 17 groups of invention, shows that paragraph (d) recites "separation process which separates a first plastic type from a second plastic type and is enhanced by the narrow surface to mass distribution, the process involving either electrostatic sorting, froth flotation, or density differential alterations..." Thus paragraph (d) contains a Markus group since it recites alternative forms of the enhancement of the separation process. With respect to paragraph (d), there are no claims directed to the alternative form of froth flotation or density differential alternatives.

806.04(d) [R-3] Definition of a Generic Claim

In an application presenting three species illustrated, for example, in Figures 1, 2, and 3, respectively, a generic claim should read on each of these views; but the fact that a claim does so read is not conclusive that it is generic. It may define only an element or subcombination common to the several species.

****** In general, a generic claim should **require* no material element additional to those **required by* the species claims, and ****** each of the species *>claims* must require all the limitations of the generic claim.

****** Once a **generic claim* is allowable, all of the claims drawn to species in addition to the elected species which **require* all the limitations of the generic claim will ordinarily be **allowable* over the prior art in view of the **allowability* of the generic claim, since the additional species will depend thereon or otherwise **require* all of the limitations thereof. When all or some of the claims directed to one of the species in addition to the elected species do not **require* all the limitations of the generic claim, ****** see MPEP § **821.04(a)*.

806.04(e) [R-5] Claims Limited to Species

Claims are definitions *>or descriptions* of inventions. *Claims >themselves* are never *species*. The scope of a claim may be limited to a single disclosed embodiment (i.e., a single species, and thus be designated a *specific species claim*)*. Alternatively, a claim may **encompass* two or more of the disclosed embodiments** (and thus be designated a *generic or genus claim*).

Species ** always >refer to* the ** different embodiments >of the invention*. Species may be either independent or related as disclosed (see MPEP § 806.04 and § 806.04(b)).

803.02 [R-5] Markush Claims

A Markush-type claim recites alternatives in a format such as "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925). The members of the Markush group (A, B, and C in the example above) ordinarily must belong to a recognized physical or chemical class or to an art-recognized class. However, when the Markush group occurs in a claim reciting a process or a combination (not a single compound), it is sufficient if the members of the group are disclosed in the specification to possess at least one property in common which is mainly responsible for their function in the claimed relationship, and it is clear from their very nature or from the prior art that all of them possess this property ...

This subsection deals with Markush-type generic claims which recite a plurality of alternatively usable substances or members. ... In applications containing a Markush-type claim that encompasses at least two independent or distinct inventions, the examiner may require a provisional election of a single species prior to examination on the merits. ...

Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable **, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

In the petition, applicants argue that "the claims the Examiner argues group 10 excludes, do not exclude triboelectric separation from the processes that are enhanced by narrow surface to mass distribution. Rather, these claims are silent with respect to the processes encompassed by a separation process..enhanced by a narrow surface to mass distribution." Applicants' argument is correct. Since these claims are silent with respect to the processes encompassed by a separation process...enhanced by a narrow surface to mass distribution, they require no material additional to those required by the forth flotation or density differential alternatives; and accordingly, are "generic" to all elements of the Markus group set forth in paragraph (d) of claim 15. The claims that the examiner withdrew for prosecution pertain to features that are required for any of the Markush group of paragraph (d) of claim 15. For example, claim 19 recites "subjecting the plastic-rich mixture to the sequence of processes includes separating the plastic-rich mixture into different types of plastic material," and claim 30 recites "the preprocessing step includes air aspiration." All of the elements of the Markush group require the step of "subjecting the plastic-rich mixture to the sequences of processes" (see claim 15, line 25) and a "preprocessing step" (paragraph (a) of claim 15). The "subjecting" and "preprocessing" steps are independent of the separation process which includes triboelectric separation. Accordingly, it was improper for the examiner to withdraw these claims.

The application will be promptly returned to the examiner for consideration of claims 16, 18-23, 25-27, 30-42, 54, 55, 58 and 63-68.

Any questions concerning this decision should be referred to Quality Assurance Specialist Teri Luu at (571) 272-7045.



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